

## **REMARKS**

Reconsideration and allowance of this application are respectfully requested in view of the amendments made to amendments and the following arguments.

Original claims 1-11 have been cancelled in favor of new claims 12-17 which have been drafted to expedite the prosecution and also to more specifically define applicant's invention. These new claims also overcome the Examiner's objection in paragraph 4 of the Action.

The Examiner rejected all of the original claims 1-11 under 35 U.S.C. 103(a) as follows:

(1) Claims 1-6 and 9-11 were rejected (par. 6 of the Action) as being unpatentable over Chao in view of the Search manual.

(2) Claims 7-9 were rejected (par. 19 of the Action) as being unpatentable over Chao in view of the Search Manual and further in view of the Electronic Publishing Guide (Note that this is the second time claim 9 was rejected).

(3) Claims 1-2 and 4-11 were again rejected (par. 26 of the Action) as being unpatentable over Finseth in view of Applicant Admitted Prior Art (AAPA).

(4) Claim 3 was again rejected (par. 42 of the Action) as being unpatentable over Finseth in view of AAPA and further in view of Angelucci.

Applicant respectfully submits that all of the presently active claims 12-17 are properly allowable in this application.

As is well recognized, for an obviousness rejection under 35 U.S.C. 103(a), the Examiner has the initial burden of making a prima facie case of obviousness by the presentation of adequate evidence (e.g. see In re Thrift, 63 USPQ2d2002 (CAFC 9/9/02)). Additionally, the cited prior art must teach or suggest all the claim limitations without using the teachings of applicant's disclosure or any other impermissible hindsight. (e.g. see In re Valeck, 20 USPQ2d1438 (CAFC 199)). Also, see MPEP 2143.01.

With regard to the evidence required to provide a prima facie showing of obviousness, note In re Lee, USPQ2d1430 (CAFC 1/18/02) which holds that an obviousness determination may not substitute the common knowledge of one skilled in the art for the required specific evidentiary support required for a 35 U.S.C. 103 rejection.

Independent claim 12 will first be considered.

Note that claim 12 not only requires that text in document files having different formats be downloaded and converted to duplicate text files (elements (a), (b) and (c)), but additionally require that the document text files be enabled for viewing at the hit locations (element)), and also that the unconverted downloaded documents files be enabled for viewing the same corresponding hit locations as found by the search of the duplicate text files (element(f)).

Applicant respectfully submits that no combination of the cited references teaches the combinations defined by claims 12. Claim 16 (the only other independent claim) contains similar limitations as claim 12 and likewise is not taught by any combination of the references.

Regarding Chao, it is not seen where Chao discloses and teaches the enabling of viewing of the duplicate text files at the hit locations, and also enabling the viewing of the unconverted document files at the same hit locations. The Examiner's combination with the Search Manual for support in this regard fails since the Search manual collection derived from the downloaded documents clearly does NOT contain the actual documents (see "Index" at the bottom of page 1 and the last sentence on page 2). Further note that there is no teaching whatsoever of the additional recitation provided by claim 14 which additionally requires "means for utilizing a "next hit" or "previous hit" button to view other hit locations in said duplicate text files.

The combination of Chao, the Search Manual and the Electronic Publish Guide also fails in teaching applicant's claims since, as pointed out above, the combination of Chao and the Search Manual do not in the first instance teach viewing both the duplicate text files and the unconverted document files at the locations where hits occurred.

Regarding Finseth, this patent is not pertinent as a teaching since it is concerned with providing reduced images of downloaded web pages in order to facilitate the viewing and accessing of search engine results. No text searching is involved, as required by applicant's claims. The combination of Finseth with AAPA even when considered along with Angelucci is likewise inadequate.

In view of the foregoing, it is respectfully submitted that all of the presently active claims 12-17 in this application are allowable. Allowance of this application is accordingly respectfully solicited.

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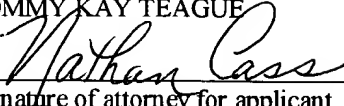
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